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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91227978
Party	Plaintiff Combined Insurance Company of America
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Combined Insurance Company of America,	:	
an Illinois corporation,	:	
	:	Opposition No.
Opposer/Petitioner,	:	91227978
	:	
v.	:	Cancellation No.
	:	92064138
The Insurance Source,	:	
a South Carolina corporation,	:	
	:	
Applicant/Registrant.	:	

Hon. Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451
Attn.: Trademark Trial and Appeal Board

MEMORANDUM OF POINTS AND AUTHORITIES IN OPPOSITION TO
MOTION TO CONSOLIDATE

Applicant/Registrant The Insurance Source ("TIS") seeks to consolidate a cancellation proceeding filed by Combined Insurance Company of America ("Combined") against TIS's



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registration for We make health insurance easier. , and an opposition proceeding filed by Combined against TIS's application for the

word mark **WE MAKE HEALTH INSURANCE EASIER.** As support for its motion, TIS asserts that the "two proceedings involve the identical parties, identical counsel, identical and related marks, and identical issues."

Combined firmly disagrees with TIS's assertions in support of consolidation, and respectfully points out that the only commonality between the two proceedings is shared parties and counsel. The two proceedings do not involve "identical and related marks" as stated by TIS, but instead involve two materially distinct and different marks:



WE MAKE HEALTH INSURANCE EASIER.

It is plainly apparent that one mark includes a shield design element and TIS's INSURE-U.COM mark/website address. The only shared component of the two marks, "WE MAKE HEALTH INSURANCE EASIER.," appears in a smaller font at the bottom of the



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mark. Since the two proceedings involve different marks, TIS's remaining arguments are not well taken and ignore strong evidence against consolidation.

Besides the fact that TIS's marks are each materially different and distinct marks, the standards of review in the opposition and cancellation proceedings are different, in that TIS enjoys a presumption of validity in the cancellation action, meaning that Combined bears the burden to establish a prima facie case that TIS's registration is invalid. In contrast, there is no such presumption in the opposition proceeding, meaning that Combined's burden is lower than in the cancellation proceeding. As a result, consolidation of the proceedings may disadvantage Combined in the opposition proceeding, where Combined enjoys a lower burden to prove its case against TIS's application for the **WE MAKE HEALTH INSURANCE EASIER.** mark.

In light of the material differences between TIS's marks and the different burdens on Combined in the opposition and cancellation proceedings involving those different marks, any

efficiency gains from consolidation would be scant, if any. Indeed, the prejudice and inconvenience to the parties provide a sufficient basis to deny the motion to consolidate these proceedings.

BACKGROUND

Combined is a leading provider of individual supplemental accident, disability, health, and life insurance products. With a tradition of more than 90 years of success, Combined is one of Ward's Top 50[®] Performing Life-Health Insurance Companies and was named the number one Military Friendly[®] Employer by G.I. Jobs magazine in 2015 and 2016.

Combined started using the **LET'S MAKE THIS EASY** mark in the United States at least as early as October 2007 in connection with its life, accident, and health insurance.

Combined filed a Notice of Opposition against TIS's Application No. 86/734,955 for **WE MAKE HEALTH INSURANCE EASIER**. on May 18, 2016 (Opposition No. 91227978). On July 19, 2016, Combined filed a Petition for Cancellation against TIS's



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Registration No. 4,979,513 for

(Cancellation No. 92064138). In both the opposition and cancellation proceedings, Combined pled its Registration Nos. 3,517,921 for LET'S MAKE THIS EASY; Registration No. 3,573,647 for COMBINED INSURANCE. LET'S MAKE THIS EASY; and Registration No. 4,901,156 for HAGAMOS ESTO FÁCIL.

ARGUMENT

Consolidation should be denied due to the prejudice and likely inconvenience that would be caused if TIS's motion were granted. It is simply not true, contrary to TIS's assertion, that the "marks being opposed and objected to are nearly identical."

TIS's registered and applied-for marks,



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and **WE MAKE HEALTH INSURANCE EASIER.**,

are different marks with distinguishing characteristics and components. Perhaps most significantly, TIS's



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mark contains its shield logo and INSURE-U.COM house mark, both of which are displayed in a larger size than the relatively smaller slogan, "WE MAKE HEALTH INSURANCE EASIER."

Due to these distinctions between TIS's two marks, the substantive grounds of the two proceedings -- likelihood of confusion under Section 2(d) -- must be analyzed differently in each of the proceedings. As such, the consolidation of distinct arguments as to each of the two marks within the confines of one "parent" case will complicate rather than streamline the proceedings and will conflate rather than clarify the issues to be decided.

Moreover, the standards of review in the opposition and cancellation proceedings are different, in that TIS enjoys a presumption of validity in the cancellation action, meaning that Combined bears the burden to establish a prima facie case that

TIS's registration is invalid. In contrast, there is no such presumption in the opposition proceeding, meaning that Combined's burden is lower than in the cancellation proceeding. As a result, consolidation of the proceedings may disadvantage Combined in the opposition proceeding, where Combined enjoys a lower burden to prove its case against TIS's application for the **WE MAKE HEALTH INSURANCE EASIER.** mark. Accordingly, there is no merit to TIS's bald assertion that consolidation will "save the parties and the Board considerable time, effort, and expense, and would greatly simplify the proceedings."

TTAB case law supports Combined's position that consolidation should be denied. For instance, the Board sustained an applicant's objections to consolidation of allegedly similar marks based on "differences between the design characteristics of the various marks." *Envirotech Corp. v. Solaron Corp.*, 211 USPQ 724, 726 (TTAB 1981). TIS has not cited any case law to support its position.

Each of TIS's marks is distinct and will require its own analysis and consideration with respect to Combined's claims. In such a circumstance, the cost savings and convenience are de minimis.

CONCLUSION

For the foregoing reasons, TIS's motion to consolidate should be denied.

Respectfully submitted,

COMBINED INSURANCE COMPANY OF
AMERICA

Date: August 24, 2016

By:



Timothy D. Pecszenye
Matthew A. Honyk
Its Attorneys

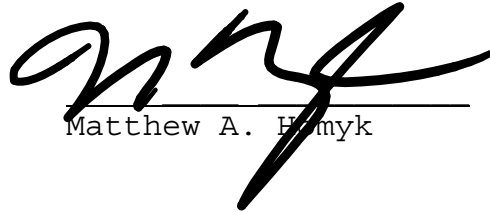
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CERTIFICATE OF SERVICE

I, Matthew A. Homyk, do hereby certify that I have on this 24th day of August, 2016, mailed by first class United States Mail, postage prepaid, the foregoing MEMORANDUM OF POINTS AND AUTHORITIES IN OPPOSITION TO MOTION TO CONSOLIDATE to the following:

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